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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,173	11/24/2003	Robert A. Moss	MOSR01NP	7011
24197	7590	11/16/2005	EXAMINER	
KLARQUIST SPARKMAN, LLP			HOLZEN, STEPHEN A	
121 SW SALMON STREET			ART UNIT	
SUITE 1600			PAPER NUMBER	
PORTLAND, OR 97204			3644	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,173	Applicant(s) MOSS, ROBERT A.	
	Examiner Stephen A. Holzen	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 10-27 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 10-27, 39-41 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/31/2005 have been fully considered but they are not fully persuasive.
2. Applicant has attempted to amend around the restriction requirement. The examiner is not however convinced that the claims are not restrictable. They are still related via combination/subcombination where the subcombination requires a second chamber not required by the combination. The subcombination has different utility in a different combination such as an electrically fired air gun. (Instead of a cocking air gun).
3. Re Stuchlik: Applicant has asserted that Rod portion 236 is stationary. The examiner agrees with this assertion. The applicant however has broadened the claim, and therefor the examiner does not believe that the claims are allowable, and needed to reconsider the scope of the claims.

Election/Restrictions

4. Newly amended claims 42 and 43 are directed to an invention that is independent or distinct from the invention originally claimed in claim 1 for the following reasons:
5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 7, 10-27, 39-41, 44 drawn to an air gun, classified in class 124, subclass 70.

- II. Claims 42 and 43, drawn to an air gun, classified in class 124, subclass 70.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). The subcombination requires a second chamber not required by the combination. The subcombination has different utility in a different combination such as an electrically fired air gun. (Instead of a cocking and firing air gun).

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 42 and 43 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-4, 7, 10, 11-12, 14-25, 39, 41, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Goepfert (5,154,157). Goepfert disclose a compressed air gun having two pistons contained within cylinders that are connected to a cocking lever and separated by a hinge rod. Lever 44 is connected to both pistons (9) and (11) by joint rods (46) and (47; see Figure 1). Goepfert discloses a compressed gas chamber (8), a barrel (4), a check valves (16), a firing valve (22), shuttle valve (25), a safety mechanism (53), a cocking a firing mechanism (40 & 90, 88, 89, 44, 48). It should be appreciated that the low-pressure cylinder has a front and back volume on each side of the piston. Further it should be appreciated that the applicant has not claimed that the compressed air source is a compressed CO₂ cylinder, and instead claims wherein "the fluid source comprise carbon dioxide". The examiner asserts that although Goepfert does not disclose a compressed CO₂ cylinder, the prior art never the less anticipates the claim, where ambient air inherently comprises CO₂. (Pumping the ambient air inherently means that CO₂ is pumped since ambient air is comprised of O₂, N₂, and CO₂).

It should further be appreciated that the applicant has not specifically defined how the chambers and valves are connected to each other, only that a

connection exists. Therefore where the applicant has claimed a fluid chamber "connected" to the back chamber of the second cylinder, the examiner asserts that Goepfert discloses a second cylinder (8) having a front and back volume, and the back volume is "fluidly connected" to fluid chamber (15).

Since the examiner has asserted that the CO₂ is part of the ambient air, inherently the Carbon Dioxide exerts a pressure on the rest of the ambient air to maintain a constant pressure.

Furthermore it should be appreciated that the applicant's functional language in the claim does not serve to impart patentability. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitation of the claims. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-2 (Fed. Cir. 1997); Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); Ex parte Masham, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

The applicant should appreciate that the pistons and valves are capable of being actuated in the claimed functional manner. Should the applicant disagree

with the examiner's assertions, then the applicant should limit his remarks to only (1) the structural limitations of the claims (2) the capability of performing the recited functions.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 12 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Goepfert (5,154,157). 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goepfert (5,363,834). Goepfert discloses every aspect of the applicant's invention except wherein the first gas is compressed between about 400 psig and about 600 psig in the compressed gas chamber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to compress the first gas to between about 400psig and about 600psig in the compressed gas chamber since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Allen, 105 USPQ 233. (See also Sullivan 5,339,791 who teaches that chambers should be compressed between 300 and 2000 psig).

Conclusion

12. Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The examiner understands that there are significant difference between the prior art, and the currently disclosed invention. The examiner asserts however that their language and not the disclosure only limit the claims. The scope of the claims is such that the cited prior art anticipates them. However, were the applicant to more specifically claim the invention as disclosed in the specification, the examiner would be forced to consider a more narrow scope.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen A. Holzen whose telephone number is 571-272-6903. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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